

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: John Brian Pickering

Assignee: IBM Corporation

Title: Voice Processing System

Serial No.: 09/696,485 Filing Date: 10/25/2000

Examiner: Susan Iris McFadden Group Art Unit: 2654

Docket No.: GB9-1999-0107US1 Conf. No.: 3603
(a/k/a 7036-P145US)

Dallas, Texas
January 23, 2004

COMMISSIONER FOR PATENTS

P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION INVOKING THE SUPERVISORY AUTHORITY OF THE
COMMISSIONER UNDER 37 C.F.R. § 1.181**

Dear Sir:

Pursuant to MPEP § 1208.01, Appellant hereby files this Petition Invoking the Supervisory Authority of the Commissioner under 37 CFR § 1.181 due to the Examiner's Answer to Appellant's Appeal Brief containing impermissible new grounds of rejection. In particular, the Examiner cited five (5) new patents, not previously cited, in the Examiner's Answer. No formal statement of rejection has ever been made regarding these five newly cited patents. The Examiner also made a new ground for rejection of claim 27 by providing in the Examiner's Answer a new, and never previously disclosed basis, for rejection.

Claims 1-11, 13-24, and 26-27 of the present application have been rejected under 35 U.S.C. § 102(e) based on the Van Tichelen patent. However, during prosecution of the present application, the Examiner has argued that "one of ordinary skill in the art familiar with barge-in systems knows that systems that accurately recognize words which satisfy desired conditions turn off the prompt

EXHIBIT

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being generated." Thus, the Examiner suggests that the teachings not found in the Van Tichelen patent are general knowledge. However, during the prosecution prior to appeal the Examiner improperly made conclusory statements about what is "basic knowledge" and did not provide adequate support in the record for these positions. *See In re Sang-Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Recognizing this flaw in her position, in the Answer to Appellant's Brief the Examiner cites five new patents, not previously cited, to support the Examiner's alleged Official Notice of what is "basic knowledge." No formal statement of rejection has ever been made regarding these five newly cited patents. For the reasons discussed below, these five newly cited patents should not be relied upon to support the 35 U.S.C. § 102(e) rejections.

Since the Examiner never cited these five references prior to her Answer, the Board cannot consider their teachings and suggestions. "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." Manual of Patenting Examining Procedure ("MPEP") § 706.02(j), citing *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

Furthermore, "37 CFR 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. . . . A new prior art reference cited for the first time in an examiner's answer generally will constitute a new ground of rejection." *See MPEP* § 1208.01. MPEP § 1208.01 further provides that: "Any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely (37 CFR 1.181(f)) raised by way of a petition under 37 CFR 1.181(a)." Accordingly, Appellant has filed this Petition.

With regard to the rejection of claim 27, the Examiner's Answer provides a new basis for this rejection, not previously disclosed, by citing to new alleged teachings in the Van Tichelen patent. Accordingly, for the reasons discussed above, the Examiner's untimely argument should be treated as

another ground for rejection, and should not be considered by the Board. However, even if the Examiner's argument can be considered, it does not adequately support rejection of claim 27. The Examiner again takes the position that Van Tichelen inherently teaches an aspect of Applicant's claimed invention. In particular, the Examiner asserts that Van Tichelen inherently teaches "determining if said audio input is speech input." However, the Examiner again does not provide sufficient rationale or evidence necessary to show inherency. *See MPEP § 2112 ("examiner must provide rationale or evidence intending to show inherency")*. The Examiner has not offered sufficient evidence that makes it clear that the missing descriptive matter is necessarily present in the Van Tichelen reference.

For the reasons recited herein, the Appellant respectfully objects to the Examiner raising new grounds of rejection in the Answer to Appellant's Brief, and submits that the Board should not consider such new grounds for rejection, including the teachings of the five newly cited patents. Therefore, Appellant respectfully requests such a decision in response to this Petition.

The Commissioner is hereby authorized to deduct from Deposit Account No. 50-0563 in the name of IBM Corporation, the amount of \$130.00, being the amount specified in 37 C.F.R. 1.17(h) for this Petition. The Commissioner is also authorized to deduct any other amounts required for this Petition and to credit any amounts overpaid to Deposit Account No. 50-0563.

Respectfully submitted,



Michael P. Adams
Attorney for Appellant(s)
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CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence (along with any item referred to as being enclosed herewith) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 23, 2004.


Signature

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